

REMARKS/ARGUMENT

Applicant responds herein to the Office Action dated May 6, 2005.

Request for Personal Interview:

A personal interview with the Examiner is respectfully requested. Applicant's representative will contact the Examiner by telephone to set a mutually convenient date and time.

Regarding the Claims in General:

Claims 2-9, 11, and 13-21 remain pending without change.

Regarding the Prior Art Rejections:

In the outstanding Office Action, claims 2-9, 13-19, and 21 were rejected as being unpatentable over Itani et al. published European Patent Application No. EP 1 158 435 (Itani) in view of Gupte et al. published U. S. Patent Application 2001/0034225, and Kimura U.S. Patent No. 4,706,078 (Kimura). Claims 20 and 11 were rejected as unpatentable over Itani in view of Gupte. Applicant respectfully traverses these rejections.

Itani is directed to a computer equipped with an e-mail program that permits previewing a composed message before transmission in the format of the recipient's display terminal. The Examiner correctly recognizes that Itani does not disclose, teach or suggest use of this in a compact portable wireless device, and likewise does not disclose, teach or suggest substitution of dots for the characters comprising a composed message.

To overcome these deficiencies, the Examiner has cited Gupte to show e-mail capability in a hand-held wireless device, and in the case claims 2-9, 13-19, and 21, has cited Kimura to show substitution of dots for characters.

The Examiner has justified combining the teachings of Itani and Gupte on the basis that "a person could stay in touch with their office and/or home via email while they are away as taught by Gupte". There is a subtle, but significant fallacy in this idea. While Gupte does disclose e-mail capability in cell phones, PDAs or the like, this is not what Gupte is about. Instead, Gupte is concerned with a mobile message management system (paragraph 0002) which provides "easy and quick access to select email or other electronic communication via a wireless communication device

so the user can directly act on the selected communication" (paragraph 0006). This objective is achieved by "providing selected electronic communications to a wireless communication device in response to only a single action by the user on the wireless communication device (paragraph 0007).

A person skilled in the art who was aware of both Itani and Gupte would not be inspired to provide the message previewing capability of Itani in a hand-held wireless communication system because there is no *relevant* connection between what Itani and Gupte are really about. Wireless email existed before Gupte's invention (see paragraph 0004). One skilled in the art would know this quite apart from what is disclosed in Gupte. There is nothing revolutionary, noteworthy, or even interesting about this aspect of Gupte. One skilled in the art wouldn't even give it a second thought.

Nor is there any connection between Gupte's actual concern, and that of Itani. Gupte is concerned about easy access to messages stored at a remote site, and has nothing to do with facilitating the composition of messages to be transmitted. Itani, on the other hand, is concerned only with previewing email which is being composed for transmission to a remote site, in other words, the opposite end of the email communication spectrum. Nothing in either reference inspires recognition of any connection between the two concerns.

In the end, what connects the two references is applicant's spark of creativity which revealed that email message format previewing might have utility in a hand-held wireless communication system. There is no suggestion in either reference of that utility. Only applicant himself teaches the connection.

Nor does providing the dot substitution taught by Kimura remedy the deficiencies in Itani. Kimura's contribution is not dot replacement; the reference clearly states that this is conventionally used to facilitate previewing text layout in such text preparing devices. Instead, Kimura proposes to improve on this by replacing different kinds of characters (e.g., upper and lower case letters, numbers, and symbols, etc.) with different dot patterns.

The Examiner suggests that incorporating the dot substitution of Kimura in Itani would have been obvious to save space in Itani's display. However, in Itani, there is no need to save space. There is no suggestion that Itani's monitor has a limited viewing area. Dot substitution might be useful in a hand-held email system with previewing capability, but as explained above, to provide previewing capability in a hand-held system would not have been obvious. Thus, adding the teachings of Kimura to those of Itani would be without purpose.

In summary, none of the three references, whether considered singly or together, disclose, teach or suggest providing email previewing capability in a hand-held wireless communication system in which an email character string is replaced by an array of dots. Accordingly, all of the pending claims should be allowed.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on :

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Name of applicant, assignee or
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Signature

July 15, 2005

Date of Signature

MM/LAH:cg/lac

Respectfully submitted,

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